

Remarks

Claims 40-43 are pending in the application. Claims 40-43 stand rejected under 35 U.S.C. 102(e) as being anticipated by Yao, et al. (U.S. Patent No. 5,923,089).

Applicant requests the Examiner reevaluate the pending claims and provide a sufficiently specific response to allow for the furtherance of prosecution in view of the remarks that follow.

Applicant respectfully requests identification in the asserted reference of elements which allegedly correspond to limitations of the claims in accordance with MPEP § 706 and 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. Applicants respectfully request clarification of the rejections of claims 40-43 with respect to specific references and specific references teachings therein in compliance with 37 C.F.R. §1.104(c)(2).

As one example, the Office Action on page 2 refers to, "forming conductive material within the oxide isolation grid to form a conductive grid therein" as being anticipated by "Fig. 8 (87,82,99)." However, Fig. 8 of the Yao is a graph that contains no such elements. Applicant requests that the rejections be clearly explained by identifying the portion of the cited reference corresponding to the claim elements and explaining the pertinence of that portion of the cited reference as it relates to the claim elements.

As another example, the Office Action on page 2 refers to, "forming an oxide isolation grid between silicon structures (Fig. 7 (95,97,98), at least a portion of the grid (98)", but Applicant is at a loss as to how these referenced structures relate to the

claimed elements. As such, Applicant respectfully requests an Office Action that is compliant with 37 C.F.R. §1.104(c)(2).

Again, claim 40 recites a method of forming conductive lines that includes forming an oxide isolation grid between silicon structures. Claim 40 has been amended to recite that at least a portion of the grid surrounds the lateral edges of at least one of the structures and that an upper portion of one of the structures is bare. Claim 40 goes on to recite forming conductive material within the oxide isolation grid to form a conductive grid therein and removing selected portions of the conductive grid to define interconnect lines within the oxide isolation grid. Claim 40 is allowable for at least the reason that the cited references do not teach or suggest forming an oxide isolation grid between silicon structures with at least a portion of the grid surrounding the lateral edges of at least one of the structures and an upper portion of one of the structures being bare.

Claim 40 is anticipated "only if each and every element as set forth in the claims are found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 22 USPQ2d 1051, 1053 (Fed. Cir. 1987). In order for a prior art reference to anticipate a claim it is further required that "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Furthermore, the Examiner bears the burden of factually supporting any conclusion of obviousness and the applicants need not submit any evidence of non-obviousness until the Examiner produces a *prima facie* case that the claims are

obvious. At least one of the three basic criteria that must be met when establishing a *prima facie* case of obviousness is that all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580, 582-3 (CCPA 1974).

Claim 40 is allowable for at least the reason that the cited references do not teach or suggest all the elements of claim 40. For example, the cited references do not teach or suggest forming an oxide isolation grid between silicon structures with at least a portion of the grid surrounding the lateral edges of at least one of the structures and an upper portion of one of the structures being bare. As such, claim 40 is allowable in view of the cited references and applicant requests allowance of claim 40 in the Examiner's next action.

Claims 41-43 have been amended for clerical reasons only and not for purposes of patentability. No new matter has been added through these amendments. Claims 41-43 depend from claim 40 and allowable for at least the reasons cited above regarding claim 40.

Claims 40-43 are pending and are believed to be in immediate condition for allowance. Applicant requests allowance of claims 40-43 in the Examiner's next action.

If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the Examiner is requested to contact the undersigned at (509) 624-4276, Monday through Friday, between the hours of 8:00 a.m. and 5:00 p.m. (PST).

Respectfully submitted,

Dated: 5/8/06

By: 

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